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ATTORNEY DOCKET NO FIRST NAMED INVENTOR FILING DATE APPLICATION NO. P8910-9024 E MUSSO 08/16/99 09/375,239 **EXAMINER** IM22/0403 SERGENT, R Arent Fox Kintner Plotkin & Kahn PAPER NUMBER 1050 Connecticut Avenue, N.W., Suite 600 **ART UNIT** Washington DC 20036-5339 1711 DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks** 

04/03/01

## Office Action Summary

Application No. 09/375,239 Applicant(s)

Musso et al.

Examiner

Rabon Sergent

Group Art Unit 1711



X Responsive to communication(s) filed on Feb 9, 2001	
FINAL	and the marite is closed
Since this application is in condition for allowance except for for	
A shortened statutory period for response to this action is set to ex is longer, from the mailing date of this communication. Failure to r application to become abandoned. (35 U.S.C. § 133). Extensions 37 CFR 1.136(a).	represent within the period for response will cause the
Disposition of Claims	is/are pending in the application.
Disposition of Claims	is/are withdrawn from consideration
Of the above, claim(s)	is/are allowed.
Claim(s)	Is/aic dilovou.
NO Objects 1.7, 10, 12-18, 22, and 23	15/8/6 (0)00000
	13/8/6 05/05/05
☐ Claim(s)	are subject to restriction of election requirements
See the attached Notice of Draftsperson's Patent Drawing F  The drawing(s) filed on is/are objected  The proposed drawing correction, filed on The specification is objected to by the Examiner.  The oath or declaration is objected to by the Examiner.  Priority under 35 U.S.C. § 119  Acknowledgement is made of a claim for foreign priority under Some* None of the CERTIFIED copies of the received.  The oath or declaration is objected to by the Examiner.  Priority under 35 U.S.C. § 119  Acknowledgement is made of a claim for foreign priority under Some* None of the CERTIFIED copies of the received in Application No. (Series Code/Serial Number Preceived in Application No. (Series Code/Serial Number Preceived in this national stage application from the Interpretation of the Certified copies not received:  Acknowledgement is made of a claim for domestic priority	is approved disapproved.  is approved disapproved.  Inder 35 U.S.C. § 119(a)-(d).  Ithe priority documents have been  Itherefore a substitution of the priority documents have been approved.
Attachment(s)  Notice of References Cited, PTO-892 Information Disclosure Statement(s), PTO-1449, Paper No Interview Summary, PTO-413 Notice of Draftsperson's Patent Drawing Review, PTO-94 Notice of Informal Patent Application, PTO-152	
SEE OFFICE ACTION ON T	THE FOLLOWING PAGES

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1. The request filed on February 9, 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/375,239 is acceptable and a CPA has been established. An action on the CPA follows.

2. Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It is unclear what limitations are set forth by the subject matter of claim 3. Applicants' amendment has not clarified the language. Applicants have failed to clearly address the rejection.

3. Claims 4-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have specified the compositions of claim 1 as a Markush group. As such, the compositions of claim 1 are closed to the addition of other foaming compositions which do not fall within the species of the Markush group. Therefore, the compositions of claims 4-7 are considered to be excluded from claim 1.

4. Claims 12-16 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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The claims are improperly dependent from two claims. Applicants have failed to address this rejection.

5. Claims 22 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The dependency of the claims is confusing, since the claims embody selections that are independent of claim 3.

6. Claims 1, 2, 4, 6, 7, 10, 12-18, 22, and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have used the wrong structural formula in connection with the recited compound name. For example, see VIII within claims 1 and 7.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- 8. Claims 1-3, 12, 13, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Klug et al. ('882 or '016 or '931).

Patentees disclose azeotropic compositions and their use as blowing agents for polyurethanes and polyolefins wherein compositions which correspond to applicants'

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compositions IV, V, D, and E are disclosed. See abstracts. Since azeotropic compositions are disclosed, applicants' percent compositions are considered to be inherently met by the references.

- Applicants have argued that Klug et al do not disclose that the compositions will function 9. as substitutes for CFC-11. In response, patentees' compositions are disclosed as being azeotropic; therefore, they comprise the same components in the same amounts as applicants' azeotropic compositions and, consequently, will inherently function as blowing agents to the same extent as applicants' compositions. Additionally, it is unclear with respect to exactly what patentable limitation the language pertaining to CFC-11 substitution conveys to the claim.
- Since the prior art rejection is anticipatory, the 37 CFR 1.132 declaration is ineffective to 10. remove the rejection. Furthermore, even if the rejections were obviousness rejections, the showings of the declaration are not commensurate in scope with the claims.
- Claims 1-7, 10, 12-18, 22, and 23 are rejected under 35 U.S.C. 112, second paragraph, as 11. being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear with request to exactly what limitation is to be conveyed by "as substitutes for CFC-11".

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.

R. Sergent/dh

March 31, 2001